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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

KIK-41079

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Application Number

10597951

Filed

2006-08-14

First Named Inventor

Wataru Ikeda et al.

Art Unit

1783

Examiner

Prashant J. Khatri

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/joseph j corso/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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2010-08-23

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 3 forms are submitted.

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REASONS FOR REQUEST

1. Background

A Final Rejection issued on February 23, 2010, an Amendment under Rule 1.116 filed on July 23, 2010 and an Advisory Action dated August 5, 2010 resulted in the finality of the rejection of pending claims 41-46 under 35 USC 103(a) as obvious over JP 05-016598 to Atake et al. with evidence from US patent 4,029,831 to Daunheimer et al. in view WO 00/32666 of Meisenberg et al. Claim 46 is rejected under 35 USC 103(a) as Claim 41 with the further addition of Wypch (Book).

Also, claim 44 is rejected in the Advisory Action as not further limiting claim 41.

2. Summary of Pertinent Features of the Invention

The invention generally relates to articles having a decorative layer of UV hardening resin absorbed in an ink pattern in a united decorative and protective layer. The ink pattern includes portions that absorb greater and lesser amounts of hardening resin and respectively provide the decorative layer with portions having a low gloss and a high gloss adjacent to each other. The ink pigments are a factor in the hardening resin absorption.

3. Examiner's Omissions of Elements Needed for a Prima Facie Rejection and/or Clear Errors

a) Claim 41 provides:

“An article having a surface protected by a decorative layer comprising a united layer of a non-solvent ultraviolet ray hardening resin composite absorbed in an ink pattern”.

The claimed united decorative layer is not identified to be in the prior art in the final rejection. Rather, it is urged that UV absorption/deflection by the Atake ink meets the claimed absorption of ink. As pointed out in the July 23, 2010 amendment, in Atake “it is understood that the ink controls the permeation of light into the hardening resin located below the ink by means of its translucency, but not the amounts of hardening resin absorption as in the present invention.”

There is no prior art teaching of physical absorption of hardening resin by inks. The absorption or deflection of UV electromagnetic radiation in Atake does not correspond with or suggest the claimed physical absorption of the hardening resin by the ink pattern. There is no explanation proffered as to the assumed equivalence or relationship of electromagnetic UV absorption/deflection and physical absorption.

In the sentence bridging pages 2 and 3 of the Advisory Action, the Examiner takes the position that due to the similarity of materials, the Atake material “would absorb within the patterned areas containing the opaque material.” There is an important difference in materials described below, and the similarity alleged by the examiner is not persuasive. Regardless, the Examiner’s position is contrary to the Atake teachings and showings of separate print layers “m” and hardening resin layers “3”, “23”. There is no Atake teaching that such layers unite or combine, or that the hardening resin is absorbed in the ink pattern. Thus, the Examiner’s position is necessarily based on applicants’ teachings since there is no teaching or suggestion of a united layer or absorption of the hardening resin in Atake.

The importance difference in materials which applicants’ discovered to make this invention is summarized, *inter alia*, in paragraph [0017] of the application. Applicants

use a non-solvent hardening resin to recover the adhesion of the print pattern in water pressure transfer, “whereby the ultraviolet ray hardening resin type composite is hardened in the state where the ultraviolet ray hardening type resin is wholly united with the print pattern to form a decorative layer.” Atake practices prior art solvent activation of the print pattern as discussed in the prior amendments filed on October 12, 2009 and October 13, 2009.

In fact, the Examiner concedes that “Atake is silent on the ‘non-solvent’ nature of the ionizing-radiation curable resin and matting agent”. (Final Rejection, paragraph 9, last sentence.) In this regard, Meisenberg is cited. However, this patent teaches a top-coating agent intended to protect the underlying paint layers “both in OEM and in the refinish of automobile bodies” (Col. 28, lines 44+). There is no suggestion for combining such a top-coat with the underlying paint or with an ink. Neither Atake nor Meisenberg teaches that the top-coat should permeate the ink in order to form the claimed united layer. The obvious combination of Meisenberg and Atake is to provide a separate protective top-coat as already taught in Meisenberg and in Atake.

Even if Meisenberg is combined with Atake, there is no teaching that the Atake solvent activation of the print layer may be eliminated since such is only taught by applicants. Thus, there is no suggestion for the proposed combination and, even if the combination is assumed, it does not result in the claimed invention since solvent activation of the print layer is taught by Atake. Moreover, neither Atake nor Meisenberg teaches the absorption of the top-coating agent by the ink layer or that such absorption provides gloss variation, and therefore, any assumed combination to teach or suggest the same, is necessarily based on applicants’ teachings.

In addition, it is further urged that each and every one of the following claim 41 recitations is not disclosed or suggested by any of the art of record.

said ink pattern including adjacent ink pattern portions containing inks that absorb greater and lesser amounts of hardening resin,

said decorative layer including adjacent decorative layer portions corresponding with said ink pattern portions and respectively containing corresponding greater and lesser amounts of absorbed hardening resin,

said decorative layer portions containing greater amounts of absorbed hardening resin having a low gloss and said decorative layer portions containing lesser amounts of absorbed hardening resin having a high gloss as compared with said low gloss.

None of the above is taught in the prior art, but rather, only assumed by the Examiner based on applicants' teachings.

For example, in the final portion of the paragraph bridging pages 2 and 3 of the Advisory Action, the absence of topcoats in the invention (due to the united or combined decorative layer) and use of topcoats in Atake is acknowledged by the Examiner. This confirms that Atake does not contemplate a united decorative layer with physical absorption. However, the Examiner inexplicably cites the same and "takes the position that the ink pattern would absorb the hardening resin at the positions where there is ink". In addition to the lack of factual support, Atake's acknowledged failure to teach a non-solvent hardening resin is ignored in the Examiner's assumed position.

Claims 42 - 46 are allowable for the same reasons as indicated above.

b) Claim 45 is allowable for the same reasons as set forth above. Wypch is cited as to use of carbon black in inks and does not remedy the deficiencies of the references discussed above.

c) Claim 44 provides: "said ink includes ink pigment and said hardening resin is absorbed by said ink pattern in amounts corresponding with the amount of ink pigment in said ink pattern portions".

Claim 44 necessarily further limits claim 41 by the recitation of "ink pigments" which is not present in claim 41.

In light of the foregoing, it is submitted that the Examiner's claim rejections are entirely lacking proper factual basis or are simply based on applicants' teachings, wherefore Pre-Appeal panel review of this case is believed to be appropriate, and early action in that respect is courteously solicited.

If there are any fees required by this communication, please charge the same to Deposit Account No. 16-0820, Order No. KIK-41079.

Respectfully submitted,

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August 23, 2010